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TO: Examiner	**FROM:** Thomas L. Evans
COMPANY: U.S. Patent And Trademark Office	**DATE:** December 22, 2005
FAX NUMBER: (571) 273-8300	**TOTAL NO. OF PAGES (INCLUDING COVER SHEET):** 5
YOUR REFERENCE NO.: U.S. Pat. App. No. 09/859,565	**OUR REFERENCE (C/M) NO.:** 003797.00014
RE: Response To Restriction Requirement	

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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jeffrey H. ALGER ET AL.

Application No.: 09/859,565

Filed: May 16, 2001

For: Merchant Branded Software

Examiner: N. Vig

Art Group: 3629

Attorney Docket No.: 003797.00014

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at (503) 273-8300 on the date specified below:

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Commissioner for Patents
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Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement dated November 22, 2005, Applicants elect to prosecute claims 1-3, 5-12, 14-17, 19-22, 24 and 25 **with traverse**. Applicants respectfully point out that the outstanding Restriction Requirement is clearly improper, and should be withdrawn.

The MPEP expressly directs:

> If the search and examination of an entire application can be made without *serious burden*, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (See MPEP §803, *emphasis added*).

Applicants respectfully submit that the Examiner cannot possibly argue that examination of all of the claims in this application presents an undue burden, **as the Examiner already has examined all of the restricted claims.** More particularly, the Examiner issued an Office Action

on March 10, 2005, in which the Examiner indicated that he had examined each of claims 1-3, 5-12, 14-17, 19-22, 24 and 25. Presumably, the Primary Examiner performed this examination by conducting a search of the prior art in accordance with MPEP §904, as required. This section of the MPEP states:

> The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art...
>
> The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed.

Applicants point out that the amendments to the claims made in the Amendment of June2, 2005, could not have necessitated the instant restriction requirement. For example, Office Action indicted that each of claims 1-29 and 38-46 had been properly examined. Nonetheless, the Examiner now has made a restriction between these claims, even though claim 1 has been amended only to incorporate the subject matter recited in multiple canceled dependent claims (i.e., claims 4, 13, and 18) and claim 26 has been amended only to incorporate subject matter previously recited in claim 27. Having purportedly completed a full examination of the subject matter of the restricted claims in accordance with MPEP §904, the Primary Examiner cannot now say that the continued examination of these claims, without further amendments, presents an undue burden requiring a restriction of these claims.

Moreover, the Examiner has expressly acknowledged that the search for all but one of the restricted groups is the same (i.e., Class 705, Subclass 1). Accordingly, the restriction between groups II through VI is unecessary on its face.

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Applicants respectfully point out that they should not be penalized for attempting to further the prosecution of this application by amending previously dependent claims into independent form, as the Examiner would do by the outstanding Restriction Requirement. Further, Applicants have paid the examination fees associated with all of the claims in this application, and were therefore entitled to a proper examination of these claims in accordance with MPEP §904. If the Examiner performed such an examination before issuing the first Office Action, then the instant Restriction Requirement should be unnecessary.

Accordingly, in view of the foregoing arguments, Applicants respectfully submit that the outstanding restriction requirement is improper, and ask that it be withdrawn.

With regard to the additional election of species Requirement, Applicants respectfully point out that this requirement is moot in view of Applicants' election of claims 1-3, 5-12, 14-17, 19-22, 24 and 25. Applicants point out, however, that this election of species requirement is improper for the reasons discussed in detail above.

It is believed that no fees are required for the consideration and entry of this Response. If, however, the Commissioner believes fees are required, he is authorized to charge such fees to Deposit Account No. 19-0733.

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Further examination on the merits is respectfully awaited.

Respectfully submitted,

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Date: December 22, 2005

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